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PATENT & TRADEMARK OFFICE

Appln. No.: 10/682,483
Response Dated March 5, 2007
Reply to Restriction and Election Requirements of November 22, 2006

BSI-210US6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/682,483
Applicant: George Goicoechea
Filed: 10/9/2003
Title: BIFURCATED ENDOLUMINAL PROSTHESIS
TC/A.U.: 3738
Examiner: Javier G. Blanco
Confirmation No.: 1455
Docket No.: BSI-210US6

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR :

This is in response to the Restriction and Election Requirements stated in the Office Communication dated **November 22, 2006**.

The Examiner requires that claims of either Group I comprising claims 54-75 and 77-85 drawn to an endoluminal prosthesis comprising connected bodies or Group II comprising claim 76 drawn to a method of implanting an endoluminal prosthesis be elected for prosecution. Applicants elect to prosecute Group I. This election is made without traverse.

The Examiner also requires Applicants to elect a single disclosed species from each of three groups of species for prosecution on the merits.

Applicants elect:

Species B: Figure 6 from the Stent Group. Claims 54-60, 61, 62, 63-67, 68, 69-75, 77, 78, 80, 81, 82, 83, 84, and 85 read on that species.

Species A: Figure 4B from the Means for Securing Juxtaposed Apices Group. Claims 54-60, 63-67, 69, 70, 71, 73, 74, 75, 77, 78, 80, 81, 82, 83 read on that species.

Species A: Figure 8 from the Introducer Group. Claims 76 and 79 read on that species.

Applicants note that the Office Communication has identified claim 54 as its own species: Species F of the Stent Group. The Office Communication states that Species F of the Stent Group is "wherein the first and second segments and the

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connector are formed from a single length of wire." However, claim 54 reads at least on Species B of the Stent Group. At least the following portions of the specification show that the wireforms in Figs. 1A, 1B, 2A, and 2B are included in the embodiment identified as Species B (Figure 6) of the Stent Group:

- Page 4, line 26-page 5, line 13
- Page 5, lines 14-24
- Page 8, lines 8-20
- Page 22, line 17-page 23, line 1
- Page 23, line 7-page 24, line 4
- Page 27, lines 3-13
- Page 29, lines 5-12

Claim 54 also reads on Species A of the Means For Securing Juxtaposed Apices Group. At least the following portion of the specification shows that neighboring hoops of the wireforms identified above are secured together by securing means and that the securing means are used with the wireforms in Figs. 1A, 1B, 2A, 2B and 6.

- Page 25, lines 1-21

Applicants respectfully submit that the PTO's designation of claim 54 as a species is improper because "claims are never species." MPEP 806.04(e). "Claims are always the specifically different embodiments." MPEP 806.04(e). Applicants therefore respectfully traverse the election requirement to the extent that claim 54 has been designated as Species F.

Applicants also note that the Office Communication has identified claim 63 as its own species: Species G of the Stent Group. However, claim 63 reads at least on Species B of the Stent Group. The Office Communication states that Species G of the Stent Group is "wherein the first tubular segment has a different radial strength than the second tubular segment." In addition to the portions of the specification identified above with respect to claim 54, the following portions of the specification show that the wireforms in Figs. 1A, 1B, 2A, and 2B and therefore Species B (Figure 6) of the Stent Group include "wherein the first tubular segment has a different radial strength than the second tubular segment":

- Page 23, lines 11-15
- Page 24, lines 5-17
- Page 25, line 27-page 26, line 8
- Page 26, lines 19-25

As above, Applicants respectfully submit that the PTO's designation of claim 63 as a species is improper because "claims are never species." MPEP 806.04(e). "Claims are always the specifically different embodiments." MPEP 806.04(e). Applicants therefore respectfully traverse the election requirement to the extent that claim 63 has been designated as Species G.

Respectfully submitted,

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JLC/SW/dhm

Dated: March 5, 2007

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The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

March 5, 2007

Joshua L. Cohen